

**DETAILED ACTION**

This is a first action following a request for continued examination. Claims 1-26 are pending. Claim 27 has been cancelled.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 March 2008 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 20 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Daniels (U.S. Patent No. 4,313,688).

Claim 20: Daniels discloses a method for supporting a deck comprising placing a non-wood element (Figure 1, element 21) below an existing wood ledger (22), the non wood element extending along the length of the wood ledger (though the non-wood portion does not extend along the entire longitudinal length of the ledger, it does extend along a portion of the length of the ledger) and attaching the non-wood element (21) to the wood ledger and structural component (second board parallel and attached to 22) that the existing wood element was attached.

Claim 22: the non-wood element (21) has an extended lip (Figure 8, element 35) that supports the wood ledger (22) and portion of joist (second board parallel and attached to 22).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-4, 7, 8 and 11-19** are rejected under 35 U.S.C. 103(a) as being anticipated by Thompson (U.S. Patent No. 3,875,712).

Claim 1: Thompson discloses an apparatus having a first frame member (Figure 2, element 28) having an outer perimeter (this is an inherent feature as the member is a channel section and virtually any perimeter is an outer perimeter), a second frame member (15) having an outer perimeter (inherent), the first member having a spacing element (Figure 4, element 25) the spacing element abuts an outer perimeter of the first member, and a flashing element (52) associated with the first member and a portion of the element is beyond the outer perimeter (in the direction toward what would be the ground) of the first frame member. While Thompson discloses a flashing element (52) which has a length (in the vertical direction) it does not disclose the length substantially equal to the length of the first or second frame member, though the length can be adjusted as shown. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP

Art Unit: 3635

2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claim 2: the spacing element (25) is a lip.

Claim 3: the spacing element includes a connector (41).

Claim 4: the lip (25) is positioned so that the first surface (Figure 4, 25) and second surface (15) are coplanar.

Claim 7: a fastener (used by holes 52a and 18a).

Claim 8: the spacing element (25) is attached to a wall (Figure 1 where 13 is connected to wall of trailer) and adapted to hold a plurality of joists (Figure 1, element 25).

Claim 11: a plurality of spaced ledges (Figure 4, elements 41, side opposite end of 41) which correspond to the spacing between the plurality of joists.

Claim 12: a flashing element (Figure 2, element 52) attached to an edge of a framing member most distant from the spacing element.

Claim 13: the flashing element is integral with the first frame member at an edge most distant from the spacing element.

Claim 14: Thompson discloses a ledger with a first edge (Figure 4, element 33), a second edge (31) and a spacing element (36) associated with the first edge the spacing element abuts the first edge, and a flashing element (52) associated with the second edge, and positioned outside the space between the first edge and second edge. While Thompson discloses a flashing element (52) which has a length (in the vertical direction) it does not disclose the length substantially equal to the length of the first or second frame member, though the length can be adjusted as shown. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claim 15: the flashing element (52) associated with the second edge (31) and is perpendicular to the first edge and second edge (the flashing element extends to what would be to the ground which would make it perpendicular to the first and second edges.)

Claim 16: the phrase "adapted for...edifice," lines 1 and 2, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 17: the spacing element (36) has a built in pocket (33,36,43). The phrase "adapted to receive a joist," line 2, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 18: the ledger further comprises a joist (18) the spacing element (36) includes a support surface (portion 36a proximate 33) between first and second edges of a joist (22 and 18), and the support surface is parallel to the first and second edges.

Claim 19: the spacing element (36) includes a support surface (41) coplanar with the first edge (22) of the joist.

**Claims 1, 8 and 10** are rejected under 35 U.S.C. 103(a) as being anticipated by Zamerovsky (U.S. Patent No. 5,533,310).

Claim 1: Zamerovsky discloses an apparatus having a first frame member (Figure 2, element 24a) having an outer perimeter (an inherent feature, see rejection of Claim 1 under Thompson, above), a second frame member (22b) having an outer perimeter and a spacing element (31) on the first member, the spacing element abuts an outer perimeter of the first frame member, a flashing element (portions 85, 86) associated with the second member and a portion of the flashing element is beyond the outer perimeter of the second frame member (as it extends to the "ground" it extends beyond the frame member.) While Zamerovsky discloses a flashing element (85, 86) which has a length (in the vertical direction) it does not disclose the length substantially equal to the length of the first or second frame member, though the length can be adjusted as shown. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior

art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claim 8: the frame member is attached to a wall (Column 3, lines 5-10). The phrase "adapted to hold a plurality of joists" line 3, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 10: the joists (26) are made of wood.

**Claims 5 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Horn (U.S. Patent No. 3,875,707).



Claim 5: Thompson discloses the claimed invention except for an adhesive that attaches the first and second frame members. Horn discloses a metal frame for a deck (Figure 3) where the metal pieces are adhered by welding (e.g. Column 3, lines 24-26). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use welding to adhere the first and second members in Thompson in order to strengthen the connection between the frame members as it is well known in the art that a weld produces a bond that is stronger than the metals that are bonded.

Claim 6: Thompson discloses a fastener (used in conjunction with 52a) to fasten the first and second frame members.

**Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Parisien (U.S. Patent No. 5,483,773).

Claim 9: Thompson discloses the claimed invention including that the frame is metal, but does not disclose that the frame is aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the metal frame in Thompson of aluminum because of its

density properties and it is well known in the art to use aluminum in building frames.

**Claims 21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels in view of Parisien (U.S. Patent No. 5,483,773).

Claim 21: Daniels discloses the claimed invention except that the non-wood element (24) is made of aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the non-wood element in Daniels of aluminum because of its density properties and it is well known in the art to use aluminum in such elements.

Claim 23: Daniels discloses placing a sleeve (21) over an existing post (23) associated with a deck, but does not disclose the sleeve is made of aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make sleeve in Daniels of aluminum because of its density properties and it is well known in the art to use aluminum in such elements.

**Claims 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels.

Claim 24: Daniels discloses the claimed invention including a wood post (23) and a non-wood post (24). Daniels does not disclose replacing an existing post with a non-wood post. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the wood post in Daniels with the non-wood post because non-wood posts typically have a longer life span than wood posts and are not subject to rot over time.

Claim 25: the non-wood post (24) includes a post and sleeve (21).

Claim 26: the non-wood post includes a flange (Figure 10 element 38).

#### ***Response to Arguments***

4. The following addresses applicant's remarks/arguments dated 17 March 2008:

#### **35 USC §102(b) rejection:**

Applicant's amendments to the claims overcome the rejection and they are withdrawn. However, see above how the references qualify as prior art under 35 USC §103.

Regarding the definition of "flashing element", the applicant requested clarity for the definition in conjunction with the use of the prior art of record. The examiner respectfully noted that what applicant noted as "flashing" in the specification is element 1420 (see Fig. 14). By reading the specification and observing the drawings, the "flashing" as shown is a strip of material. By these observations, the examiner concluded that the members as shown above in the prior art of record are flashing in that they are strips of material. The examiner further interprets the definition of "flashing" as a piece of material that acts as a covering. The prior art of record acts as a covering as that they cover other members in the prior art of record. The same argument applies to the Zamerovsky reference (as noted in applicant's arguments page 10.)

Regarding the limitation addressing the spacing element (arguments page 8), the examiner respectfully disagrees that the Thompson reference (cited above) does not have a spacing member that abuts the perimeter of the first frame member. The examiner indicated portion 25 as the spacing member, and the first frame member is element 28. The spacing member abuts the

outer perimeter of the first frame member at the portion of what would be the edge of the member (as shown in Fig. 4.

With respect to the spacing element as argued in the Zamerovsky reference (cited above), applicant only claims "a spacing element" without providing any further structural limitation. The examiner concludes that element 31 is a spacing element that abuts an outer perimeter (which is the basic perimeter) of the member.

Regarding the rejection of Claim 20 (page 13), the examiner respectfully disagrees that the Daniel's reference (cited above) does not disclose a ledger. As shown in applicant's specification and drawings, the ledger is portion 1400 (see Fig. 14.) By this interpretation, the examiner maintains the position that Fig. 1, element 22 of Daniels satisfies the structural limitations of the ledger as claimed in that it is a horizontal member that serves the function of a ledge. The limitation "existing" is also satisfied by the prior art of record in that the ledger does exist prior to the completion of the construction of the invention.

Regarding the rejection of claims 24-26, the examiner agrees that only a single reference (Daniels) was cited for a 35 USC §103 rejection. The examiner further maintains the position that all of the structural elements are present in the

reference, including a wooden post and a non-wooden post, and that replacing a wooden post with a non-wooden post would be obvious to one of ordinary skill in the art for the reasons noted above. As a result, a secondary reference is not necessary, as the examiner is not taking official notice.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635

/Basil Katcheves/

Primary Examiner, Art Unit 3635